

Appl. No. : 09/771,043
Filed : January 26, 2001

REMARKS

Claims 4, 7, and 10 are now pending in this application. Applicant respectfully requests reconsideration of the application in view of the following remarks.

Notice of References Cited

Applicants respectfully point out that the date of the Kawai, et al. reference (Analytical Biochemistry vol. 209, pages 63-69, 1993) is given incorrectly as "1992" on Form PTO-892. Correction is respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 4, 7, and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kawai, et al. (Analytical Biochemistry vol. 209, pages 63-69, 1993).

The Examiner asserts that Kawai et al. teach immobilizing oligonucleotides by contacting the oligonucleotides onto polystyrene plates and fixing by UV irradiation at 254 nm, single stranded probes with 60 repeats of sequence, hybridization and detection.

Applicants respectfully disagree. The cited reference does not teach the polymer of part 2 of claims 4 and 7. This is clear from Table 1 of the Kawai, et al. reference which provides the structures of the oligonucleotides used in the reference. None of the sequences of Table 1 have a "polymer comprising a compound having an unsaturated bond, said polymer being bonded to the 3' end or the 5' end or both ends of the nucleic acid, said polymer being a polymer of a monomer having a base selected from the group consisting of thymine, a thymine derivative, uracil and a uracil derivative with an average degree of polymerization of the polymer being not less than 3 and not more than 100" as set forth in the present claims. While some of the nucleic acid sequences of Kawai, et al. are attached to biotin, biotin is not a polymer and does not have a base. Biotin does not meet the limitations recited in the claims.

In order to have anticipation, the anticipatory reference must teach all of the elements of the claimed invention. In this case, Kawai, et al. do not teach all of the claimed elements, at least the elements recited in claims 4 and 7, part 2. As claim 10 depends from claim 4 and contains all of the limitations of claim 4, claim 10 also is not anticipated by Kawai.

In view of Applicants' arguments, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

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CONCLUSION

In view of the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Sept. 7, 2004

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